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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,417	08/14/2001	Eric E. Rice	55090US002	1221
32692	7590	03/17/2004	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			NORDMEYER, PATRICIA L	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 03/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/929,417	Applicant(s) RICE ET AL.	
	Examiner Patricia L. Nordmeyer	Art Unit 1772	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 February 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Attached sheets.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-24.

Claim(s) withdrawn from consideration: 25-31.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 02202004.
10. ☐ Other: _____

DETAILED ACTION

Continuation of #5: The application is not placed in condition for allowance because the prior art of record still reads upon the claim limitations. The arguments presented by the Applicant will be responded to below.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Eigenmann, Wyckoff and Jonnes all teach retroreflective articles meant to be used in a roadway to reflect light back at the drivers and to show delineation between the lanes on the road surface. Therefore, it would be obvious to one versed in the art of retroreflective articles to modify the Eigenmann pavement tape with elements from both Wyckoff and Jonnes.

In response to Applicant's argument that Eigenmann fails to teach a unitary retroreflective article having a width that is substantially equal to the first portion width, Eigenmann clearly shows that the retroreflective element covers the whole width of the first portion of the road marker (Figure 4). The retroreflective elements are present along the width of the marker and only between the second portion elements, R.

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In response to Applicant's argument that Jonnes fails to teach a unitary retroreflective article having a width that is substantially equal to the first portion width, Jones clearly shows that the retroreflective element covers the whole width of the first portion of the road marker (Figure 1, # 14).

In response to Applicant's argument that the combination of Eigenmann, Wyckoff and Jonnes fail to teach the retroreflective articles exhibit a first color and the second portion of the pavement marking exhibiting a second color that contrasts with the first, Wyckoff teaches a pavement marker made with intermediate segments that display a bright or colored appearance when compared to the retroreflective segments (Column 6, lines 2 - 4). Therefore, it would be obvious to one skilled in the art at the time of the invention to change the color of the second portion to contrast with the color of the first portion as taught by Wyckoff.

In response to Applicant's argument that the prior art fails to teach the limitations of claim 15, Eigenmann discloses a retroreflective article having a first portion containing retroreflective articles with a width less than the marker width and a height less than a second portion that surrounds the first portion on at least two opposing sides (Figure 3).

In response to Applicant's argument that the prior art fails to teach the retroreflective elements extending substantially along the length of the marking, Eigenmann teaches a marker where the retroreflective element extends substantially along the length of the marker (Figure 3).

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The term "substantially" allows for some space along the length of the marker to be free of retroreflective elements.

Conclusion

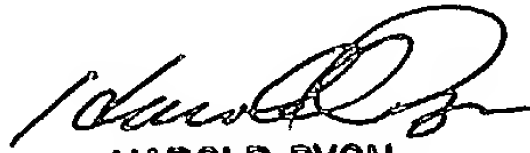
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571) 272-1496. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patricia L. Nordmeyer
Examiner
Art Unit 1772

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HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

3/2/04